

## REMARKS

### A. Front Page of Office Action

The cover page of the December 27, 2002 office action indicates that claims 1-14 are pending and that claims 1-14 are rejected. The status of the present application also indicates that "prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*."

The applicant agrees that claims 1-14 are pending, but disagrees with the front page summary of the office action, which does not reflect the contents of the office action. The office action rejects pending claims 1-14 under 35 USC 102(e), to the contrary of the summary of the office action, which indicates that "this application is in condition for allowance except for formal matters."

### B. Summary and Response to Items Enumerated in the Office Action

#### 1. Item 1

In item 1, the examiner quotes the 35 U.S.C. 102(e).

In reply, the applicant notes this.

#### 2. Item 2

In item 2, the examiner rejects claims 1-14 under 35 USC 102(e). The examiner states that:

Claims 1-14 are rejected under 35 USC 102(e) as being anticipated by Halpern et al. (US Patent No. 6,282,711).

In reply, the applicant traverses these rejections.

#### 3. Item 3

In item 3, the examiner rejects claim 1 under 35 USC 102(e). The examiner states that:

As per claims [sic] 1, Halpern et al teach a method of using software products that are offered via a network (*see abstract, fig 1*) comprising inquiring about a software (*software components*) product from an offer server (*remote server, 102*) by a user via a terminal device (*client system 101*) downloading (*downloading*) the software product from the offer server via the network onto the terminal device in response to the inquiry of the user (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*) activating (*installing*) a software component (*subset*) of the software product; starting a communication by way of the software component with a usage processing server regarding a usage of the software product in response to a call of the software product in the terminal device of the user (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*); providing, by the software component in a framework of the communication, data to the usage processing

server; and checking the data, by the usage processing server, and then making a determination selected from the group consisting of: whether usage of the software product is approved with respect to the inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts (*see abstract, fig 1, 2, column 6 line 29-67*).

In reply, the applicant respectfully traverses this rejection.

The Halpern et al. patent (hereinafter Halpern) is directed to downloading a custom made software with user selected components from a distributed processing network. Halpern discloses that all of the components and options selected by a user is first packed into one package, then the package is downloaded by the user, unpacked and installed into the user's system.

The present invention, to the contrary, is directed to determining whether a user is approved to download a software product and whether the charge incurred by the download is paid by the user or the software product account. These determination processes are done by a communication that is started by a call at the user's terminal device after the user has downloaded and activated the software from a network.

Thus, the present invention and the Halpern are aimed at solving different problems. With respect to claim 1, Halpern does not anticipate the claimed features of (1) "starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response to a call of said software product in said terminal device of said user," and (2) "checking said data, by said usage processing server, and then making a determination selected from a group consisting of: whether usage of said software product is approved with respect to said inquiring user, and whether charging operations are carried out on user accounts and provider of software product account." Therefore, claim 1 is not anticipated by Halpern. For these reasons, withdrawal of the rejection of claim 1 is respectfully requested.

#### **4. Item 4**

In item 4, the examiner rejects claims 2 and 3 under 35 USC 102(e). The examiner states that:

As per claims 2 and 3, Halpern et al teach a method further comprising operating the usage processing and the offer server by a network provider (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses these rejections.

For all of the reasons set forth above for claim 1, claims 2 and 3 are also in condition for allowance because claims 2 and 3 depend on claim 1. Therefore, withdrawal of the rejections of claims 2 and 3 is respectfully submitted.

**5. Item 5**

In item 5, the examiner rejects claim 4 under 35 USC 102(e). The examiner states that:

As per claims [sic] 4, Halpern et al teach a method further comprising using a web server for a server selected from the group consisting of the offer server and the usage processing server (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 1, claim 4 is also in condition for allowance because claim 4 depends on claim 1. Therefore, withdrawal of the rejection of claim 4 is respectfully submitted.

**6. Item 6**

In item 6, the examiner rejects claim 5 under 35 USC 102(e). The examiner states that:

As per claims [sic] 5, Halpern et al teach a usage processing server comprising: a usage processing module for processing a software product downloaded from a network; wherein the usage processing server is contacted by the software product after the software product has been downloaded into a terminal device of a user and has been activated; and wherein usage processing data required to perform usage processing are delivered to the usage processing server (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

With respect to claim 5, Halpern does not anticipate the claimed features of (1) "said usage processing server is contacted by said software product after said software product has been downloaded into a terminal device of a user and has been activated," and (2) "wherein usage processing data required to perform usage processing are delivered to said usage processing server." Therefore, withdrawal of the rejection of claim 5 is respectfully requested.

**7. Item 7**

In item 7, the examiner rejects claim 6 under 35 USC 102(e). The examiner states that:

As per claims [sic] 6, Halpern et al teach a usage processing server further comprising: a data store in which a software product identification of the software product and type of usage processing data that prescribe a type of usage processing of the software product are stored by

the usage processing module, and wherein the usage processing module registers the software product (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 5, claim 6 is also in condition for allowance because claim 6 depends on claim 5. Therefore, withdrawal of the rejection of claim 6 is respectfully submitted.

**8. Item 8**

In item 8, the examiner rejects claim 7 under 35 USC 102(e). The examiner states that:

As per claims [sic] 7, Halpern et al teach a usage processing server wherein: the usage processing data required comprises a software product identification of the software product and a user identification (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 5, claim 7 is also in condition for allowance because claim 7 depends on claim 5. Therefore, withdrawal of the rejection of claim 7 is respectfully submitted.

**9. Item 9**

In item 9, the examiner rejects claim 8 under 35 USC 102(e). The examiner states that:

As per claims [sic] 8, Halpern et al teach a usage processing server wherein: the usage processing comprises performing an access control (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 5, claim 8 is also in condition for allowance because claim 8 depends on claim 5. Therefore, withdrawal of the rejection of claim 8 is respectfully submitted.

**10. Item 10**

In item 10, the examiner rejects claim 9 under 35 USC 102(e). The examiner states that:

As per claims [sic] 9, Halpern et al teach a usage processing server wherein: the usage processing comprises performing a usage charging in the software product on user accounts and provider accounts (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 5, claim 9 is also in condition for

allowance because claim 9 depends on claim 5. Therefore, withdrawal of the rejection of claim 9 is respectfully submitted.

**11. Item 11**

In item 11, the examiner rejects claim 10 under 35 USC 102(e). The examiner states that:

As per claims [sic] 10, Halpern et al teach a usage processing server according to claim 5, wherein the usage processing module keeps statistics about usage contacts that have taken place and about results of processing of the usage contacts (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 5, claim 10 is also in condition for allowance because claim 10 depends on claim 5. Therefore, withdrawal of the rejection of claim 10 is respectfully submitted.

**12. Item 12**

In item 12, the examiner rejects claim 11 under 35 USC 102(e). The examiner states that:

As per claims [sic] 11, Halpern et al teach a software product, comprising: a software component that is activated when called by the software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to the usage processing server in the framework of the communication; wherein the software product can be downloaded into a terminal device by a user via a network in response to an inquiry from the user (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

With respect to claim 11, Halpern does not disclose any determination process, which determines whether a user is approved to download the software or whether the charge is paid by the software account or the user's account. Thus, Halpern does not disclose the claimed feature of a "software component that is activated when called by said software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to said usage processing server in the framework of said communication." Therefore, withdrawal of the rejection of claim 11 is therefore respectfully requested.

**13. Item 13**

In item 13, the examiner rejects claim 12 under 35 USC 102(e). The examiner states that:

As per claims [sic] 12, Halpern et al teach a software product wherein the usage processing data comprises: software product provider data; and software product identification; and wherein the usage processing data is dynamically determined user data (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 11, claim 12 is also in condition for allowance because claim 12 depends on claim 11. Therefore, withdrawal of the rejection of claim 12 is respectfully submitted.

**14. Item 14**

In item 14, the examiner rejects claim 13 under 35 USC 102(e). The examiner states that:

As per claims [sic] 13, Halpern et al teach a software product wherein the software component interacts with the user to produce the dynamically determined user data (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*).

In reply, the applicant respectfully traverses this rejection.

For all of the reasons set forth above for claim 11, claim 13 is also in condition for allowance because claim 13 depends on claim 11. Withdrawal of the rejection of claim 13 is respectfully submitted.

**15. Item 15**

In item 15, the examiner rejects claim 14 under 35 USC 102(e). The examiner states that:

As per claims [sic] 14, Halpern et al teach a method for the generation of a software product that is offered via a network (*see abstract, fig 1*), comprising the steps of installing a software component in source code of the software product of a software manufacturer by using a software development kit provided by a usage processing provider (*see abstract, fig 1, 2, column 4 lines 44-5 line 47*). activating [sic] the software component when called by the software product; starting a communication by the software component with a usage processing server after the step of activating the software component; sending, by the software component, usage processing data that are required for performing usage processing to the usage processing server in the framework of the communication (*see abstract, fig 1, 2, column 6 line 29-67*).

In reply, the applicant respectfully traverses this rejection.

For the reasons set forth above for claims 1, 5, and 11, the rejection of claim 14 is improper because Halpern does not disclose the claimed features of (1) "activating said software

component when called by said software product,” (2) “starting a communication by said software component with a usage processing server after said activating said software component,” and (3) “sending, by said software component, usage processing data that are required for performing usage processing to said usage processing server in the framework of said communication.” Hence, withdrawal of the rejection of claim 12 is respectfully submitted.

**16. Item 16**

In item 16, in response to the applicant’s arguments, the examiner states that:

Applicant’s arguments filed November 22<sup>nd</sup>, 2002 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art (Halpern et al.) fail to teach starting a communication by way of the software component with a usage processing server regarding a usage of the software product in response to a call of the software product in the terminal device of the user and the usage processing server is contacted by the software product after the software product has been downloaded into a terminal device of a user and has been activated, further usage processing data required to perform usage processing are delivered to the usage processing server starting a communication by the software component with a usage processing server after activating the software component; sending, by the software component, usage processing data that are required for performing usage processing to the usage processing server in the framework of the communication. Examiner respectfully disagrees with applicant characterization of Halpern et al.’s inventive concept. Halpern et al. teach [sic] an inventive concept of delivered installation package contains only the programs, data and local installation process by connecting to the remote server system via a telecommunications link within a distributed processing network, such as the Internet. Engaging in a dialog with the server which provides information links to server-side databases, the user chooses all software components and options that he desires his software package to have. Such a package may be, for example, a subset of a software suite. After selection of all options, a single package is manufactured on the server (*see abstract*).

In reply, the applicant points out that the examiner’s response did not address the claimed features of (1) “checking said data, by said usage processing server, and then making a determination selected from a group consisting of: whether usage of said software product is approved with respect to said inquiring user” and (2) “whether charging operations are carried out on user accounts and provider of software product accounts.” Since Halpern does not disclose these features, the rejections of all claims are improper and should be withdrawn.



31518

PATENT TRADEMARK OFFICE

3/26/03  
Date

Respectively Submitted,

Richard A. Neifeld, Ph.D.  
Registration No. 35,299  
Ruay Lian Ho  
Registration No. 48,110

**Printed: March 25, 2003**

**Y:\Clients\Siemens\SIEM0023UUS\Drafts\Amendment\_021227.wpd**

## APPENDIX

### MARKED UP VERSIONS OF THE CLAIMS SHOWING AMENDMENTS

**Please amend claims 1-4, 12, and 14 as follows:**

1. (Once Amended) A method for using software products that are offered via a network, comprising [the steps of]:

inquiring about a software product from an offer server by a user via a terminal device;  
downloading said software product from said offer server via said network onto said terminal device in response to said inquiry of said user;  
activating a software component of said software product;  
starting a communication by way of said software component with a usage processing server regarding a usage of said software product in response to a call of said software product in said terminal device of said user;

providing, by said software component in a framework of said communication, data to said usage processing server; and

checking said data, by said usage processing server, and then making a determination selected from a [the] group consisting of: whether usage of said software product is approved with respect to said inquiring user, and whether charging operations are carried out on user accounts and provider of software product accounts.

2. (Once Amended) The method of claim 1, further comprising [the step of] operating said usage processing server by a network provider.

3. (Once Amended) The method of claim 3, further comprising [the step of] operating said offer server by a network provider.

4. (Once Amended) The method of claim 4, further comprising [the step of] using a web server for a server selected from the group consisting of said offer server and said usage processing server.

5. A usage processing server comprising:  
a usage processing module for processing a software product downloaded from a network;

wherein said usage processing server is contacted by said software product after said

software product has been downloaded into a terminal device of a user and has been activated;  
and

wherein usage processing data required to perform usage processing are delivered to said usage processing server.

6. A usage processing server according to claim 5, further comprising:

a data store in which a software product identification of said software product and type of usage processing data that prescribe a type of usage processing of said software product are stored by said usage processing module, and

wherein said usage processing module registers said software product.

7. A usage processing server according to claims 5, wherein:

said usage processing data required comprises a software product identification of said software product and a user identification.

8. A usage processing server according to claim 5, wherein:

said usage processing comprising performing an access control.

9. A usage processing server according to claim 5, wherein:

said usage processing comprises performing a usage charging of said software product on user accounts and provider accounts.

10. A usage processing server according to claim 5, wherein:

said usage processing module keeps statistics about usage contacts that have taken place and about results of a processing of said usage contacts.

11. A software product, comprising:

a software component that is activated when called by said software product and that subsequently starts communicating with a usage process server and delivers usage processing data required for performing usage processing to said usage processing server in the framework of said communication;

wherein said software product can be downloaded into a terminal device by a user via a network in response to an inquiry from said user.

12. (Once Amended) A software product according to claim 11, wherein said usage processing data comprising:

software product provider data; [and]

software product identification; and

wherein said usage processing data is dynamically determined user data.

13. A software product according to claim 12, wherein said software component interacts with said user to produce said dynamically determined user data.

14. (Once Amended) A method for the generation of a software product that is offered via a network, comprising [the step of]:

installing a software component in source code of said software product of a software manufacturer by using a software development kit provided by a usage processing provider;

activating said software component when called by said software product;

starting a communication by said software component with a usage processing server after said [step of] activating said software component;

sending, by said software component, usage processing data that are required for performing usage processing to said usage processing server in the framework of said communication.